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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/231,714	01/15/1999	PATRICK E. PATTERSON	09939/003001	2717

7590 10/27/2004
McGUIRE WOODS LLP
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McLEAN, VA 22102

EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/231,714

Applicant(s)

PATTERSON, PATRICK E.

Examiner

Paul H Kang

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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Continuation of 5. The request for reconsideration has been considered but does NOT place the application in condition for allowance because applicants' arguments are not deemed to be persuasive. Examiner's response to applicants' arguments are presented below.

Claim Rejections - 35 USC § 101

1. The rejection under 35 USC §101 is hereby WITHDRAWN.

Claim Rejections - 35 USC § 112

2. At the time the Final Rejection was mailed the patent application 09/199,150 and resulting US patent 6,751,670 were previously unpublished and not yet issued as a patent, thus unavailable to the examiner for review. Consequently, the examiner in rejecting claims 1-27 under §112, required the applicant to amend the disclosure to include the material incorporated by reference as required by MPEP 608.01(p). However, in light of the recent issue of said '670 patent to Patterson, the examiner withdraws the previous requirement. However, after reviewing the disclosure found in the '670 patent, the examiner finds the disclosure insufficient to overcome the rejection of claims 1-27 under §112.

3. The applicants' arguments made in reference to the §101 rejection, now withdrawn, argued the scope of specific limitations and urged the examiner to consider all the words of the claimed invention. Although the arguments were presented in response to the §101 rejection, they are deemed pertinent to the §112 issues, thus referenced here.

The applicant argued in substance that the examiner makes a “circular argument that the invention as claimed lacks utility,” and that “the claimed invention is indeed [enabled and sufficiently described] when all the words of the claimed invention are considered.” Remarks, page 11. The applicants argue “[i]n particular, ‘selectively deny access to the requested data’ (e.g., electronic content) imparts a distinction to the meaning of the claimed invention that at least certain operations such as, for example, viewing , listing, saving, printing, or the like, may be selectively denied, and alternatively, access may be selectively denied to parts of the requested data while other parts may be accessed.” The applicant cites col. 1, lines 43-45, col. 3, lines 5-13, col. 1, lines 64-67 and col. 2, lines 41-48 as enabling disclosure. If the claims and the disclosure of the ‘670 patent were read as urged by applicant, then the requirement for §112 would be satisfied. However, the examiner disagrees with such interpretation for the reasons set forth below.

4. The examiner rejected claims 1-27 under 35 USC §112 as not satisfying the written description because the specification did not describe in such a way as to reasonably convey to the one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner also rejected claims 1-27 as not satisfying 35 USC §112, as failing to comply with the enablement requirement since the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner held that the Specification does not provide a written description, nor enable one skilled in the art to make and/or use the invention comprising “wherein the instructions are

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executable instructions and collect the notification information and selectively deny access to the requested data until the notification is transmitted.”

5. The supporting disclosure in the ‘670 patent teaches that in response to a “triggering event” the system performs the step of “selectively granting access” to data “based on a result of the attempted transmission of the notification information.” See ‘670, col. 1, lines 43-45, col. 3, lines 5-13, col. 1, lines 64-67 and col. 2, lines 41-48.

However, the disclosure does not provide a written description nor enablement for “transmitting notification when the data is accessed” and “selectively deny access to the requested data until the notification information is transmitted.”

6. The distinction between the disclosure found in the ‘670 patent and the present invention is two fold. Firstly, ‘670 teaches the use of a “triggering event.” ‘670 discloses this triggering event to be an “attempt to access” the data. In contrast, the invention as claimed reads “transmitting notification when the data is accessed.” This is the equivalent “triggering event” of the present invention as claimed. The scope of this limitation, when given the broadest reasonable interpretation, does not include an “attempt to access” said data, but is limited to actual access to said data.

Secondly, applicants suggest that “selectively deny access” should be interpreted to mean either that at least certain operations may be selectively denied or that access may be selectively denied to parts of the requested data while other parts may be accessed. The disclosure of ‘670 does not support this reading. ‘670 teaches that in response to a triggering event, such as an attempt to access data, the system selectively grants or denies access “based on a result of the attempted transmission of the notification

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information.” See ‘670, col. 2, lines 33-47. This information may be used to verify an authorized user, for instance. Id. However, ‘670 does not provide enablement nor provide a written description of the functions as suggested by the applicant. Mere mention by ‘670 that electronic content may include at least one file of data, text, graphics, audio, video, or an executable instructions is insufficient to provide the requisite support for “selectively” denying access to at least certain operations or to parts of the requested data while other parts may be accessed.

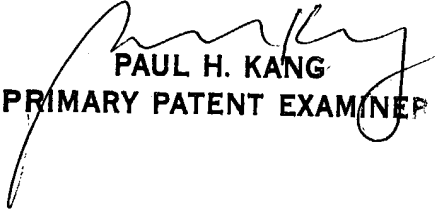
For the reasons set forth above, the applicants arguments are not deemed to be persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. After October 26, 2004, all calls should be placed to (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H. KANG
PRIMARY PATENT EXAMINER